

PTO/SB/21 (09-04)

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Total Number of Pages in This Submission

Application Number	10/696,727
Filing Date	October 28, 2003
First Named Inventor	Simonson, Rush E.
Art Unit	3732
Examiner Name	Michael J. Araj
Attorney Docket Number	025929-000200US

ENCLOSURES (Check all that apply)

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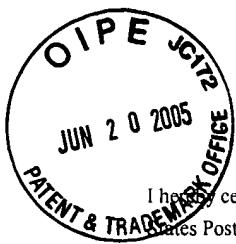
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Townsend and Townsend and Crew LLP		
Signature			
Printed name	Guy W. Chambers		
Date	June 16, 2005	Reg. No.	30,617

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On June 16, 2005

TOWNSEND and TOWNSEND and CREW LLP

By: Linda Burgess

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Simonson, Rush E.

Application No.: 10/696,727

Filed: October 28, 2003

For: VERTEBRAL IMPLANTS
ADAPTED FOR POSTERIOR
INSERTION

Customer No.: 20350

Confirmation No. 6338

Examiner: Araj, Michael J.

Technology Center/Art Unit: 3732

**RESPONSE TO RESTRICTION
REQUIREMENT AND
INTERVIEW SUMMARY**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir: .

In response to the Office Action mailed May 27, 2005, the Examiner required restriction to one of the following groups under 35 USC § 121:

- | | |
|-----------|---|
| Group I | Claims 1-10, drawn to an implant, classified in class 623, subclass 17.11 |
| Group II | Claims 11-14, drawn to a method, classified in class 606, subclass 60 |
| Group III | Claims 15-19, drawn to a method, classified in class 623, subclass 17.15 |

Group IV Claim 20, drawn to a method, classified in class 23, subclass
17.16.

The Examiner further required that Applicant elect from the following species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

- I. Figure 1
- II. Figure 16
- III. Figure 22
- IV. Figure 35

In response to the Examiner's restriction requirements, Applicant provisionally elects, with traverse, Group IV and the species of Figure 16. Pending claims 2, 5-6, 8-13, 15 and 18-20 presently read on the species of Figure 16.

Before explaining the basis for Applicant's traverse, Applicant would first like to thank Examiners Araj and Robert for speaking with Applicant's attorney by telephone on June 7, 2005. The reasons for Applicant's traverse described in this Response were discussed during the telephone interview. Applicant's attorney was encouraged by the Examiners to put those reasons for traverse in written form.

35 U.S.C. § 121 provides that the Examiner may issue a restriction requirement where "two or more independent and distinct inventions are claimed in one application." The term "independent" means that there is no disclosed relationship between the two or more

subjects disclosed, that is, they are unconnected in design, operation, or effect. MPEP § 802.01. The term "distinct" means that two or more subjects as disclosed are related, but are capable of separate manufacture, use or sale as claimed "AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." *Id* (emphasis in MPEP). Moreover, even if claims are properly determined to be "independent or distinct," the Examiner must still examine the entire application on the merits if the search and examination of the entire application can be made without serious burden. MPEP § 803.

In the present case, Applicant respectfully submits that the restriction requirements do not comply with the statutory and MPEP standards. More specifically, the Examiner has indicated for restriction groups I, III and IV that Prosthesis Class 623 will need to be searched and indicated for restriction group II that the Surgery Class 606 will need to be searched. The three subclasses in Prosthesis Class 623 identified by the Examiner, namely subclass 17.11 (implantable prosthesis - spine bone), 17.15 (implantable prosthesis - having opposed bone plates which move relative to one another) and 17.16 (implantable prosthesis - spine bone, including spine disc spacer between adjacent spine bones), are right next to one another. The subclass of Surgery Class 606 identified by the Examiner is directed to internal fixation means (i.e., subclass 60).

All of the inventions set forth in the present application pertain to intervertebral spinal implants to replace damaged discs and methods for inserting them. Applicant submits that all the pending product claims can be examined by a search of Prosthesis Class 623, subclass 17.16 (implantable prosthesis - spine bone, including spine disc spacer between adjacent spine

bones) and all the pending method claims can be examined by a search of Surgery Class 606, subclass 60 (surgery - internal fixation means). As such, to the extent any restriction requirement is appropriate, it would only be between Applicant's product claims 1-10 and Applicant's method claims 11-20. Applicant is particularly confused by the Examiner's assertion that he will need to search Prosthesis *product* class 623 for Applicant's *method* claims 15-20.

Further, the alleged distinctions between method restriction groups II, III and IV have little or no meaning. More specifically, the Examiner tries to distinguish between Applicant's method claims by arguing that some require a partial discectomy and accessing the facing superior/inferior vertebrae, while others do not. In actual surgery, though, the damaged disc will always need to be at least partially removed before the spinal implant is inserted and both the superior/inferior vertebrae will need to be accessed. For this reason, there is no colorable distinction between method restriction groups II, III and IV and, as such, all the method restriction groups should be combined into a single method restriction group.

Finally, contrary to the requirements of Section 803 of the MPEP, the Examiner fails to provide any reasoned basis for the further requirement of restriction to Figures 1, 16, 22 or 35. More specifically, the Examiner fails to explain why examining all of Applicant's spinal implant species together would require searches of additional classes, constitute a "serious burden" or involve "patentably distinct" inventions.

For these reasons, Applicant respectfully requests that the Examiner withdraw his restriction requirement or, if any restriction is still necessary, limit that restriction requirement to a simple election between product claims 1-10 and method claims 11-20.

Appl. No. 10/696,727

Response dated June 16, 2005

Reply to Restriction Requirement of May 27, 2005

PATENT

Attorney Docket No.: 020915-000200US

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (415) 576-0200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Guy W. Chambers", with a stylized flourish at the end.

Guy W. Chambers
Reg. No. 30,617

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Attachments
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